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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/217,780 03/25/94 WOZNEY

J GI5202CIP

EXAMINER
JACOBSON, D

18M2/1021

ART UNIT PAPER NUMBER

LEGAL AFFAIRS DEPARTMENT
GENETICS INSTITUTE INC
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CAMBRIDGE MA 02140

1814

DATE MAILED: 10/21/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

for restriction purposes only
A shortened statutory period for response to this action is set to expire _____ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-28 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-13, 22, and 23, drawn to a molecule DNA encoding a V1-1 related protein, vectors, host cells, and a method of making a V1-1 related protein by recombinant means, classified in Class 435, subclass 69.1.

II. Claims 14-18, 20, 24, and 27 drawn to a V1-1 related protein and compositions thereof, classified in Class 514, subclass 12.

III. Claims 19, 21, 25, 26, and 28 drawn to a method of inducing tendon/ligament tissue formation, classified in Class 514, subclass 12.

The inventions are distinct, each from the other because of the following reasons:

The DNA sequences of Group I and the protein sequences of Group II are independent chemical entities and require different literature searches. The host cell and method for production claims are placed with the DNA sequences of Group I because although they have acquired a separate status in the art as shown by their different classification, they do not constitute a burden to search in addition to the DNA sequence.

The DNA molecules of Group I and the method of Group III are related because the DNA encodes the protein used in the treatment method. However, the DNA molecules are not required to practice

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the claimed method. The DNA molecules can be used in a materially different process, such as in the recombinant production of the V1-1 protein. Also, the recombinant method of Group I utilizes different starting materials and results in a different outcome than the method of Group III.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, such as in the production of antibodies specific for the V1-1 related protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of the recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Steven Lazar on 10/19/94 to request an oral election to the above restriction requirement, but did not result in an election being made. A written restriction requirement was requested by Mr. Lazar.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dian C. Jacobson whose telephone number is (703) 308-2973. The examiner can normally be reached Monday-Thursday 8:00 to 5:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax, can be reached at (703) 308-4216. The FAX number for this Group is (703) 308-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Dian C. Jacobson
Dian C. Jacobson
October 19, 1994